



PATENT 2126
Attorney Docket No. 205350
Client Reference No. 150850.02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Feliz G.T.I. Andrew et al.

Art Unit: 2126

Application No. 09/705,858

Examiner: Li B. Zhen

Filed: November 3, 2000

For: METHOD AND SYSTEM FOR
DISPLAYING TRANSIENT
NOTIFICATIONS

**TRANSMITTAL OF
APPELLANT'S APPEAL BRIEF**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.37, appellants hereby submit Appellants' Brief on Appeal.

The items checked below are appropriate:

1. Status of Appellant

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

Brief Fee Due \$500.00

3. Oral Hearing

☐ Appellants request an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

03/07/2005 HALI11 00000114 121216 09705858

02 FC:1251 120.00 DA

4. Extension of Time

- ☒ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$120.00.
- ☐ Appellant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellant has inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$120.00

5. Total Fee Due

The total fee due is:

Brief on Appeal Fee	\$500.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 120.00

Total Fee Due: \$620.00

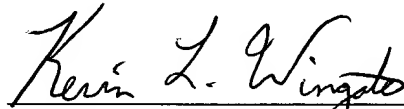
6. Fee Payment

- ☒ Charge Account No. 12-1216 the sum of \$620.00. A duplicate of this transmittal is attached.

7. Fee Deficiency.

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,



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Date: March 1, 2005



CERTIFICATE OF MAILING

I hereby certify that this APPEAL BRIEF TRANSMITTAL AND APPEAL BRIEF (along with any documents referred to as attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: March 1, 2005

Sauna M. Billups



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2126

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For: METHOD AND SYSTEM FOR DISPLAYING
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APPELLANTS' APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated June 7, 2004,
Appellants now submit their Brief.

I. Real Party In Interest

The patent application that is the subject of this appeal is assigned to Microsoft Corporation.

II. Related Appeals and Interferences

There are no appeals or interferences that are related to this appeal.

III. Status of Claims

Claims 1- 32 are currently pending in this application, stand finally rejected, and are at issue herein.

IV. Status of Amendments

There are no outstanding Amendments in this application.

V. Summary of Claimed Subject Matter

Independent claim 1 is in the Beauregard format and requires, *inter alia*, receiving a notification at a notification component 138 to provide to a user, the notification component 138 adapted to receive notifications of different notification types from a plurality of objects, determining a priority to assign the notification based on a user specified priority, deciding a notification type, and rendering the notification in accordance with the priority and the notification type. *See generally* Application Ser. No. 09/705,858 at p. 4, lines 5-23.

Independent Claim 15 requires, *inter alia*, a notification component 138 adapted to receive notifications of different notification classifications from a plurality of objects where the notification component performs the steps of determining the notification classification and rendering the notification in accordance with the notification classification and a user specified priority. *See generally* Application Ser. No. 09/705,858 at p. 4, lines 5-23.

The following explanation applies to both independent claims. There are several types of notifications. The types of notifications include mail messages, user messages, applications changing state messages, meeting reminders, stock tickers, etc. *See Id.* at p.13, lines14-p. 14, line 5. The notification component assigns each notification type a classification (i.e., a category). *See Id.* The list of classifications is extensible and includes contact, financial, e-mail, system level, and audio classifications. *See Id.* For example, the contact classification is used for meeting notices, phone notifications, and any other notification that indicates that another user wants to make contact. The financial classification is used for financial based notifications, and the audio classification is used for audio notifications. The e-mail classification is used for e-mail notifications. *See Id.*

An example of each type of classification is below. Contact classification notifications are notifications such as "Conference Room 10 in 5 minutes" for a meeting notice, and "Joe at 703-308-4357" for a phone notification. An example of an e-mail notification is "Bill from Microsoft." An example of a financial classification notification is a stock ticker such as "MSFT

up 5," an example of a system level notification is "Battery is low" and an example of an audio classification notification is "Playing Train." *See Id.*

The notification component 138 receives notifications to be rendered via an application programming interface (API). Application programs provide specify the classification and the notification to be rendered in message text form via the API. *See Id.* at p. 14, line 14 to p. 15, line 20. The text form may be in the form of a property command and text command that identifies the classification and the message text or in the form of an XML schema with a notification classification tag and a notification type tag. *See Id.* The notification classification tag provides the notification component 138 with the notification classification. The notice type tag provides the notification component 138 with the notification to be rendered and the style of rendering. The rendering styles include visual, pager, and spoken renderings (audio). The application may specify multiple rendering styles to be provided in a notification. *See Id.*

The notification component 138 renders the notification in accordance with the notification classification and the user's preferences. *See Id.* at p. 15, lines 21-22. Once a notification is received, the notification component 138 parses the notification to determine the notification classification and the notification to be rendered. *See Id.* at p. 19, lines 15-20. If the user's preferences indicate that the notification classification is enabled and the particular application is not disabled, the notification is rendered in accordance with the rendering style and priority specified in the user's preferences. The user preferences allow the user to enable or disable notification classifications globally, to enable or disable notifications from a particular application, to specify the rendering style for each notification classification, and to specify the priority in which notifications should be rendered. *See Id.* at p.15, line 21 – p. 16, line 2. Figures 3a and 3b illustrate an embodiment of the invention where a user selects his/her preferences via a dialog box.

One of the user preferences includes a pre-notification notification with the audio rendering style. If this pre-notification notification is selected, the notification component 138 alerts the user that an audio notification is arriving, which allows the user to listen for the incoming notification. Without the alert, the user may misinterpret or not hear the first few words of the notification because the user is focusing on running a task. The notification component 138 renders the audio style by converting the notification text into audio and using the speakers 197. *See Id.* at p. 16, line 23 - p. 17, line 9.

The notification component 138 may perform one or more actions when the user says a keyword or key-phrase in response to hearing the notification. For example, if the notification is a financial notification that is about the user's mutual fund performance and the user says the keyword or key-phrase (e.g., "show me"), then the notification component 138 performs a specified function (e.g., brings up the web-site of the user's mutual fund). *See Id.* at p. 17, lines 8-13.

Notifications using the visual rendering style can be rendered with a transparent display, an alpha-blended display, and a transparent alpha-blended display. *See Id.* at p. 17, lines 15-17. The user specifies the font and font size of the notifications, the color of the notifications in the displays and where on the monitor 191 that the notification is to be rendered for each notification classification. *See Id.* at p. 17, lines 17-19. The user can define any area at any position on the display 300 to render the notification. *See Id.* at p. 17, lines 21-23. Figures 5a and 5b illustrate the transparent display 310 and alpha-blended display 312. An alpha-blended display 312 is a display in which the levels of opacity or transparency are selected so that the image behind the alpha-blended display is partially visible. The image behind a transparent display 310 is completely visible.

Similar to the audio notification, the visual notification can be actionable (i.e., a function is executed when the user clicks on the display with a user selection device such as a mouse, keyboard, joystick, etc.). For example, the web-site where the user's stock portfolio is stored can be brought up when the user clicks on notifications that are about his stock portfolio or the e-mail application can be opened or be brought to the top-most window level in response to the user clicking on an e-mail notification with a user selection device. *See Id.* at p. 18, lines 6-11.

The rendering versions include a short version and a long version. For example, a short version of a notification may be "Microsoft up 2 at 82" and a long version may be "Microsoft up 2 at 82 on increased volume." For each notification classification, the user selects whether the short version or the long version should be used in rendering the notification. The applications programs 135 provide both rendering versions in the notification sent to the notification component 138. *See Id.* at p.18, line 18 – p.19 line 1.

There are two types of queues that the notification component 138 uses. The first type is a modified strict queue. Notifications in a strict queue are queued in the order they are received and are rendered in the same order. In the modified strict queue, the notifications are queued by priority and in the order they are received. They are then rendered in the same order (i.e., from

highest priority to lowest priority in the order the notifications are received in each priority level) and may be stacked vertically in the display area. The second type of queue is a flushed queue. In the flushed queue, the queue is flushed of all messages when a new notification arrives. For example, if a compact disc player changes state or changes song, the queue is flushed of previous state changes or song changes because they are out of date. *See Id.* at p. 20, lines 1-9. The notification component 138 has a history feature that keeps track of the notifications that have not been rendered. Notifications from the history may be flushed by the notification component 138 once they have been rendered to the user. Older notifications are also flushed from the history. The time period that the notifications are kept is selected by the user, and may be set for each notification classification. The user also may select how the notifications in the history are displayed. The history feature is also actionable (i.e., one or more actions are performed when the user selects a notification in the history). *See Id.* at p.20, lines 10-17.

VI. Grounds of Rejection to be reviewed on Appeal

1. Claims 1 and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,768,119.
2. Claims 2-4, 6, 10-14, 16-20, 23, and 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,768,119 in view of U.S. Patent No. 6,412,021.
3. Claims 21, 2, 30 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,768,119 and U.S. Patent No. 6,412,021 in view of U.S. Patent No. 6,542,868
4. Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,768,119 and U.S. Patent No. 6,412,021 in view of U.S. Patent No. 6,144,942
5. Claims 5 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,768,119 in view of U.S. Patent No. 6,405,204.

6. Claims 7, 8, 24 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,768,119 and U.S. Patent No. 6,412,021 in view of U.S. Patent No. 6,317,128.

VII. Argument

I. A Prima Facie Case of Anticipation Has Not Been Made With Respect to Claims 1 and 15

Independent claim 1 recites as follows:

A computer-readable medium having computer-executable instructions for performing steps comprising:

receiving a notification at a notification component to provide to a user, the notification component adapted to receive notifications from a plurality of objects and **adapted to receive notifications of different notification types**;
determining a priority to assign the notification based on a user specified priority;
deciding a notification type; and
rendering the notification in accordance with the priority and the notification type.

Independent claim 15 recites as follows:

A method of displaying a notification received from one of a plurality of objects at a notification component adapted to receive notifications from the plurality of objects and **adapted to receive notifications of different notification classifications**, the method comprising the steps of:

determining, by the notification component, a notification classification; and
rendering, by the notification component, the notification in accordance with the notification classification and a user specified priority.

It is axiomatic in the patent law that to reject a claim under 35 U.S.C. §102, each and every limitation must be found, expressly or inherently, in a single reference and arranged as

required by the claims such that the reference discloses the identical invention. *See* MPEP § 2131. Anticipation is not established if in reading a claim on something disclosed in a reference it is necessary to pick, choose, and combine various portions of the disclosure not directly related to each other by the teachings of the reference. *See Ex parte Beuther*, 71 USPQ2d 1313 (BdPatApp&Int 2003), citing *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972). A reference applied as anticipatory of the claimed invention under 35 U.S.C. §102 must be enabling so as to place one of ordinary skill in the art in possession of the claimed invention. *See Akzo N.V. v. United States Int'l Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986) cert. denied, 482 U.S. 909, (1987); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). As explained in the often-cited treatise Chisum on Patents "to constitute an anticipation, a printed publication must describe the invention. The description must be adequate to a person with ordinary skill in the art to which the invention pertains. By the weight of authority, the description must enable such a person not only to comprehend the invention but also to make it." That is, in order for a reference to be used to construct an anticipation rejection under 35 U.S.C. §102, the reference must enable one of skill in the art to make and use the claimed invention. *See Bristol-Meyers Squibb Co. v. Ben Venue Laboratories, Inc.* 246 F.3d 1368, 1374, 58 USPQ2d 1508 (Fed. Cir. 2001). Specifically, "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665, 231 USPQ 649, 653 (Fed. Cir. 1986).

MPEP §2111 specifically requires that the patent Examiner give the pending claims their "broadest reasonable interpretation consistent with the specification" for purposes of examination. *See In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). While one must be cautious not to read limitations from the specification into the claims, the specification must be considered in interpreting limitations that are explicitly recited in the claim. Indeed, this "broadest reasonable interpretation" of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

The Havekost '119 patent is directed to a process control system which monitors and uniformly displays diagnostic information of devices. *See* Havekost '119 at col. 2, lines 11-14 and teaches an alarm and event monitoring system that allows a user to prioritize the alarm and event information that is being displayed. *See* Havekost '119 at col. 3, lines 40-49. This

overcomes the problem of prior process control monitoring systems that only allow the equipment manufacturer the ability to define the alarms and events to be monitored. *See* Havekost '119 at col. 3, lines 22-33. A user sets a desired alarm priority, selecting high importance alarms for more urgent display and annunciation and rendering a lower display status to less urgent events. *See* Havekost '119 at col. 3, lines 40-49.

The area control network (ACN) of Havekost '119 is a network that is dedicated to carrying control parameters, control data, and other relevant information in the process control system of Havekost '119. *See* Havekost '119 at col. 5, lines 23-30. The ACN includes communication functionality at two levels, a remote object communications (ROC) level and a low level communications level. The ROC level controls the interface between applications and the ACN communications system. The low level communications support the interface with the TCP/IP sockets and the actual transmission of messages. *See* Havekost '119 at col. 16, lines 59-65. The ROC communication level supports communications message services including request/response, unsolicited reporting, event/alarm reporting and broadcast message service. Request/Response is a service by which applications send messages to a remote device and receive a response from the device. Unsolicited Reporting is a service for periodically sending updated data to a remote device. Event/Alarm Reporting is a guaranteed delivery message service which is used for the transmission of events, alarms and other vital information for delivery to a remote device. The broadcast message service is used to send messages to all devices on the communications network. *See* Havekost '119 at col. 17, lines 4-17.

Fig. 22 of Havekost '119 illustrates an object module that shows object relationships of various objects for handling alarm and event notifications. Various conditions are defined to be "events" including Alarms, Alarm acknowledgments, user changes (writing attributes, invoking methods, log-in/out), configuration changes to the "run-time" system (installations, de-installs, etc.), Sequential Function Chart (SFC) state changes, Operator Attention Requests (OARs), and other miscellaneous Events (non-alarm state transitions including equipment state changes). The occurrence or state transition of an event can be recorded in an Event Journal. All events are associated with one (or more) plant areas. Event occurrence records (RtEventOccurrenceRecord 2240) are captured in the Event Journal, or Journals, (RtEventjournal 2220) designated for the associated plant area (RtPlantArea 2210). *See* Havekost '119 at col. 31, line 53 to col. 32, line 2.

A user of Havekost '119 activates the Event Journal by configuring one or more Plant Areas within which the activated Event Journal captures events. On-line operation of the Event

Journal is modified under user control by disabling or enabling specified classes of events to be recorded. *See* Havekost '119 at col. 32, lines 3-8. Alarm state transitions are recorded in the Event Journal assigned to a Plant Area. All alarm state transitions shown in FIG. 23 of Havekost '119 are recorded in the Event Journal, including transitions between the Inactive/Unack'd 2314 and the Active/Unack'd state 2318. Thus an operator viewing the LAALM field in displays or alarm summaries does not see transitions between Active/Inactive states for unacknowledged alarms, these transitions are recorded in the Event Journal. *See* Havekost '119 at col. 37, line 67 – col. 38, line 9. Event journal entries for alarm state transitions include: (1) a timestamp of the alarm state transition as determined by the device (e.g. controller) detecting the alarm condition, (2) an "alarm" event type which distinguishes from other event journal entries, (3) a user-defined alarm category, (4) a current alarm priority, (5) an alarm word string as configured in the system Alarm Type table, (6) an new alarm state, (7) an attribute reference string or path for the alarmed attribute, and (8) a description string assembled from the description string configured in the Alarm Type table, with the configured (up to two) Attribute values inserted in the string. *See* Havekost '119 at col. 38, lines 11-23.

The user of Havekost '119 configures an Alarm behavior by creating Alarm Attributes (RtAttribute 2232) in Control Modules or Equipment Modules (RtModule 2230). An Alarm Attribute furnishes reference to any Boolean Attribute within the Control Module or Equipment Module containing the Attribute. Alarm Attributes are created only at the Module level. *See* Havekost '119 at col. 32, lines 9-16. First, an "Alarm Types" Table and an "Alarm Annunciation" Table are configured. Second, in an optional step, the user-defined alarm conditions are configured, setting the Boolean Attributes. Third, Alarm Attributes are created to reference the Boolean Attributes, thereby identifying the System "Alarm Type", priority, and the like. Fourth, Module "instances" are created based on Module Definitions that contain Alarms. Fifth, a presentation of Alarm information is inserted into displays (pictures) via database links, dynamic color links, and Alarm Summary links. Sixth, the "Alarm Types" and "Alarm Annunciation" Tables are configured. *See* Havekost '119 at col. 38, lines 54-64.

The "Alarm Types" Table contains columns including an Alarm Type, an Alarm Word, a category and a description string column. The Alarm Type column contains a brief description of the Alarm Type (e.g., low alarm, high alarm, communication error, change from normal ,etc. – *See* Table VI of Havekost '119), which is used to select the appropriate Type when creating an Alarm Attribute. The Alarm Word column includes a string that is returned when reading the

A.sub.-- CUALM or A.sub.-- LAALM Fields when the Alarm is Active. The category column describes a user defined word recorded in the Event Journal used to help filter/sort queries. The description string appears in the Alarm Summary Link and contains up to two place holders for Attribute value substitution at Alarm Detection time. *See* Havekost '119 at col. 39, lines 5-16.

The "Alarm Annunciation" Table contains the columns including an Alarm Priority, an Auto Acknowledgement, a WAV file and a PC speaker frequency column. The Alarm Priority designates the Alarm priority word (HIGH/MEDIUM/LOW/LOG). The Auto Acknowledgment column contains a YES/NO value indicating if alarms of this priority should be automatically acknowledged when detected and provides an opportunity to make less important alarms less "distracting." The WAV file contains a filename of a NT compatible .WAV file which is played (looping) when an Alarm is detected (within the scope of the current user) at a Workstation with a sound card. Omitting this file name indicates that no .WAV file should be played for alarms with this priority. The PC Speaker frequency sets a value used to play a tone on the PC speaker when an Alarm is detected, within the scope of the current user, at a Workstation without a sound card. A value of 0 indicates that the PC speaker should not be used for alarms with this priority. If a .WAV file and a non 0 speaker frequency are specified for the same alarm priority, the PC speaker is used only if no sound card is present. *See* Havekost '119 at col. 39, line 53 – col. 40, line 7 and Table VII.

In the broadest interpretation of Havekost '119 as summarized above, Havekost '119 discloses that the user configures an alarm behavior by creating alarm attributes. An enabled alarm attribute has either an active condition or an inactive condition. While enabled, an alarm attribute has either an acknowledged or unacknowledged state. The alarm attribute is placed in the unacknowledged condition only if the alarm attribute makes a transition from inactive to active state, unless automatically acknowledged. Alarms of Havekost '119 are annunciated according to the alarm priority (i.e., high, medium, low, log) and a different sound file is played according to the priority level (i.e., alarmhigh.wav, alarmmed.wav, alarmlow.wav). The log is entered into an event journal, which logs the occurrence of, or state transition of, an event. Users are not notified of entries in the event journal.

In terms of the present invention, Havekost '119 teaches rendering an alarm in accordance with a user specified priority. A review of Havekost '119 reveals that there is no teaching or suggestion of receiving notifications of different notification classifications (or types) or determining a notification classification (or type). No teaching or suggestion could be found in

Havekost '119 of a component that is adapted to receive notifications of different notification classifications from a plurality of objects where the component determines the notification classification and renders the notification in accordance with the notification classification and a user specified priority.

In summary, the citation of the process control system of Havekost '119 that allows a user to specify alarm priorities does not teach or suggest all of the claim requirements of claims 1 and 15. Accordingly, the examiner has failed to present a *prima facie* case of anticipation for claims 1 and 15. It is therefore respectfully submitted that the rejection of claims 1 and 15 is improper and should be withdrawn, and it is also respectfully requested that claims 1 and 15 be allowed to issue.

II. A Prima Facie Case of Obviousness Has Not Been Made With Respect to Claims 2-4, 6, 10-14, 16-20, 23, and 26-29

It is axiomatic that a *prima facie* case of obviousness may only be established if three basic criteria are met. First, there must be some suggestion or motivation, either in the cited references themselves or in the demonstrated knowledge generally available to one of ordinary skill in the art at the time the application was filed, to modify or combine reference teachings in the cited manner. Second, there must be a reasonable expectation of success in so doing. Finally, the prior art references, when combined or modified as asserted, must teach or suggest all the claim limitations. (See Manual of Patent Examining Procedure, §2143.) It is an indispensable requirement of the PTO rules, the relevant Federal statutes, and the Federal courts that the teaching or suggestion to make the claimed combination/modification and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. (See In re Vaack, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).)

The Federal Circuit has recently confirmed that a finding of obviousness based on a combination of references must meet stringent evidentiary requirements. In particular, the Federal Circuit noted that “[t]he factual inquiry whether to combine references must be *thorough and searching*... The need for *specificity* pervades [the prevailing legal] authority.” See In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (emphasis added). In the Lee decision, discussed in greater detail below, the Federal Circuit criticized as insufficient the examiner’s conclusory statement that a combination of cited references would provide certain benefits (the same benefits that the invention provided) making the combination obvious. See Id.

at 1434. In so doing, the Federal Circuit noted that the obviousness inquiry cannot be “resolved on subjective belief using unknown authority.” Id. Rather the, PTO has an obligation and choice to either develop a solid “evidentiary basis” motivating a cited combination, or forego the rejection entirely. See Id.

There is no teaching or suggestion found in the cited art, or otherwise, to combine Havekost '119 and Nguyen '021 in any manner, let alone in the cited manner. As specifically set forth by the Manual of Patent Examining Procedure §2143.01, and as articulated time and again by the Court of Appeals for the Federal Circuit, the prior art must suggest the desirability of the claimed invention. (See, e.g., Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 53 U.S.P.Q.2d 1580 (Fed. Cir. 2000); In re Gartside, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000); In re Kotzab, 208 F.3d 1352, 54 U.S.P.Q.2d 1308 (Fed. Cir. 2000); Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000).) Such a suggestion must be found from: 1) the nature of the problem to be solved; 2) the teachings of the prior art; or 3) the knowledge of persons of ordinary skill in the art. (Id.) It is not enough to set forth broad conclusory statements regarding the teaching of the references as such do not constitute evidence, rather the showing must be *clear and particular*. (See In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (emphasis added).)

In its decision in In re Lee, the Federal Circuit reiterated and clarified the principle that a conclusory and ungrounded statement of motivation to combine is legally unacceptable. Specifically, the Federal Circuit noted that conclusory statements regarding motivation to combine are in violation of the PTO’s federal mandate. (See Lee, at 1434 (“Omission of a relevant factor [i.e. motivation to combine] required by precedent is both legal error and arbitrary agency action.... Conclusory statements...do not fulfill the agency's obligation...”).) Thus, a simple statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination. The fact that a combination *can* be made to get the beneficial results that the Applicants disclosed does not amount to a motivation found *in the art* to make that very combination. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) (“The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some ‘teaching, suggestion or reason’ to combine cited references.”).

This paragraph is applicable to claims 2-4, 6, 10-14, 16-20, 23, and 26-29. A review of the teachings of Havekost '119 and Nguyen '021 reveals that, in fact, there is no disclosure or teaching in either of them that would suggest or motivate their combination. Havekost '119 describes a "process control system," that provides the ability for a user to prioritize the alarm and event information that is displayed. *See* Havekost '119, Abstract, lines 1-9. Nguyen '021, on the other hand, describes a user notification class for notifying users of application or applet state changes in a system where applications or applets that are unloaded from memory are incapable of providing feedback or user notification of state changes. The user notification class instance performs all notification functions on behalf of the application or applet. *See* Nguyen '021, Abstract, lines 3-19. None of the teachings of Havekost '119 suggests that the system of Havekost '119 could have derived any benefit from the system of Nguyen '021 that performs all notification functions on behalf of an application or applet when the application or applet is unloaded from memory. To the contrary, the system of Nguyen '021 could not be reasonably implemented in the process control alarm system contemplated by Havekost '119. A review of the teachings of Havekost '119 and Nguyen '021 reveals that, in fact, there is no disclosure or teaching in either of them that would suggest or motivate their combination.

IIa. Claim 2

Rather than provide the requisite particularized showing of the teaching or suggestion to combine Havekost '119 and Nguyen '021, the Office Action improperly relies on the teachings of one of the references to provide the motivation to combine and simply declares that it would have been obvious to combine the two references because their combination would have yielded the benefits of Applicant's invention. (*See* Office Action, p.4.) The *entirety* of the Office Action's statement regarding the motivation to combine Havekost '119 and Nguyen '021 reads as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teachings of determining a notification medium to render the notification as taught by Nguyen to the invention of Havekost because this provides multiple methods of displaying an [sic] notification such as a dialog box and changing the image or images associated with the button icon [col. 4, lines 52-67 of Nguyen].

(Office Action, p.4.)

All the examiner has done is cite what one of the references teaches and state that it would be obvious to combine the references because of what the one reference teaches. Such a statement is *not* a motivation or suggestion to actually make the combination. The fact that a combination *can* be made to get the beneficial results that the Applicants disclosed does not amount to a motivation found *in the art* to make that very combination. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001). Accordingly, the Office Action has failed to present a prima facie case of obviousness for claim 2. It is therefore respectfully submitted that the rejection of claim 2 is improper and should be withdrawn, and it also respectfully requested that claim 2 be allowed to issue.

IIb. Claims 3-4, 6, 10-14, 16-20, 23, and 26-29

Even if the combination of Havekost '119 and Nguyen '021 did contain all of the elements of claims 3-4, 6, 10-14, 16-20, 23, and 26-29, which it does not, there is no teaching or suggestion found in the cited art, or otherwise, to combine the references in any manner, let alone in the cited manner. Not only does the Office Action not provide a detailed showing of the teaching or suggestion to combine the references, it provides *no showing of any* teaching or suggestion to combine. Instead, the Office Action simply rejects these claims with the introductory wording "Havekost as modified teaches ..." and then refers to the teachings of either Havekost or Nguyen to cite which reference the Office Action states teaches what is claimed.

In view of the forgoing, it is respectfully submitted that the rejection of claims 3-4, 6, 10-14, 16-20, 23, and 26-29 is improper because it does not put forth any motivation to combine the references. (See Lee, at 1434 ("Omission of a relevant factor [i.e. motivation to combine] required by precedent is both legal error and arbitrary agency action.... Conclusory statements...do not fulfill the agency's obligation...").) Accordingly, the Office Action has failed to present a prima facie case of obviousness for claims 3-4, 6, 10-14, 16-20, 23, and 26-29. It is respectfully submitted that the rejection of claim 3-4, 6, 10-14, 16-20, 23, and 26-29 is improper and should be withdrawn and it is also respectfully requested that claims 3-4, 6, 10-14, 16-20, 23, and 26-29 be allowed to issue.

III. A Prima Facie Case of Obviousness Has Not Been Made With Respect to Claims 21, 22, 30, and 31

This paragraph is applicable to claims 21, 22, 30, and 31. As previously indicated, Havekost '119 describes a “process control system,” that provides the ability for a user to prioritize the alarm and event information that is displayed. *See* Havekost '119, Abstract, lines 1-9. Nguyen '021, on the other hand, describes a user notification class for notifying users of application or applet state changes in a system where applications or applets that are unloaded from memory are incapable of providing feedback or user notification of state changes. *See* Nguyen '021, Abstract, lines 3-19. Badt '868 describes an audio notification management system that sets a priority level for each notification arriving in a queue and teaches notifying a user of a selected notification prior to playing the notification message or querying the user whether to play the notification message. *See* Badt '868, col. 2, lines 7-12. The user responds to the query by speaking into a microphone. *See Id.* at col. 5, lines 61-66. A person skilled in the art would have no reason to look at Badt '868 when solving the problem of providing a process control system that allows users to prioritize the alarm and event information system of Havekost '119 because the audible notification of Havekost '119 is an audible alarm and the event information is sent to the a log (i.e., the event journal of Havekost '119). An audible alarm does not need a pre-notification notification because it is already audible and the sound of the alarm provides the user with the knowledge of the priority of the alarm. Nor would the person of ordinary skill in the art in the process control system field of art look to query a user if an alarm should be played because the alarm is used to signify that the process being controlled requires user interaction.

IIIa. Claim 21

Rather than provide the requisite particularized showing of the teaching or suggestion to combine Havekost '119, Nguyen '021, and Badt '868, the Office Action improperly relies on the teachings of one of the references to provide the motivation to combine and simply declares that it would have been obvious to combine the three references because their combination would have yielded the benefits of Applicant’s invention. (*See* Office Action, p.10.) The *entirety* of the

Office Action's statement regarding the motivation to combine Havekost '119 and Nguyen '021 and Badt '868 reads as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teaching of sending a pre-notification notification prior to performing the step of rendering the notification as taught by Badt to the invention [of] Havekost as modified because this prepares the user for an incoming notification.

(Office Action, p.10.)

It is respectfully submitted that the examiner has cited one of the beneficial results that one of the references teaches and stated that it would be obvious to combine the references because of what the one reference teaches. Such a statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination.

Furthermore, Badt '868 does not provide a teaching of the claimed steps missing from both Havekost '119 and Nguyen '021. Instead, Badt '868 is only relied upon to provide a teaching of the claimed step of sending a pre-notification notification prior to performing the step or rendering the notification. A review of the teachings of Havekost '119, Nguyen '021, and Badt '868 reveals that, in fact, there is no disclosure or teaching in any of them that would suggest or motivate their combination.

Accordingly, the Office Action has failed to present a prima facie case of obviousness for claim 21. It is therefore respectfully submitted that the rejection of claim 21 is improper and should be withdrawn, and it also respectfully requested that claim 21 be allowed to issue.

IIIb. Claims 22, 30, and 31

The Office Action provides *no showing* of *any* teaching or suggestion to combine the references with respect to these claims. Instead, the Office Action simply rejects these claims with the introductory wording "Havekost as modified teaches ..." and then refers to the teachings of Badt '868 to state that the combined references teach what is claimed.

It is respectfully submitted that the rejection of claims 22, 30, and 31 is improper because it does not put forth any motivation to combine the references. (*See Lee*, at 1434 ("Omission of a relevant factor [i.e. motivation to combine] required by precedent is both legal error and arbitrary agency action.... Conclusory statements...do not fulfill the agency's obligation...").)

Accordingly, the Office Action has failed to present a prima facie case of obviousness for claims 22, 30, and 31. It is therefore respectfully submitted that the rejection of claim 22, 30, and 31 is improper and should be withdrawn and it is also respectfully requested that claims 22, 30, and 31 be allowed to issue.

IV. A Prima Facie Case of Obviousness Has Not Been Made With Respect to Claim 9

As previously indicated, Havekost '119 describes a “process control system,” that provides the ability for a user to prioritize the alarm and event information that is displayed. *See* Havekost '119, Abstract, lines 1-9. Nguyen '021, on the other hand, describes a user notification class for notifying users of application or applet state changes in a system where applications or applets that are unloaded from memory are incapable of providing feedback or user notification of state changes. *See* Nguyen '021, Abstract, lines 3-19. Ruckdashel '942 is directed to a system for notifying an individual of previously scheduled events. *See* Ruckdashel col. 1, line 47 – col. 2, line 10.

The stated reason in the Office Action for combining Ruckdashel '942 is that it would be obvious to apply the teaching of a pager notification as taught by Ruckdashel '942 to the invention of Havekost '119 as modified because pager notification allows a user who is away from their computer to be notified of an event. It is respectfully submitted that the examiner has stated one of the beneficial results that one of the references teaches and state that it would be obvious to combine the references because of what the one reference teaches. Such a statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination. The fact that a combination *can* be made to get the beneficial results that the Applicants disclosed does not amount to a motivation found *in the art* to make that very combination. *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001).

Furthermore, the alarm event of Havekost '119 is for a process control system. A person skilled in the art would have no reason to look at Ruckdashel '942 in view of Havekost '119 because the notification of Havekost '119 is an audible alarm for a process control system. The monitoring of a process control system that has alarms requires a person to be on-site in order to quickly take corrective action for high priority alarms. Furthermore, the alarms of Havekost '119 are not scheduled events. Therefore, the system of Havekost '119 does not need a pager notification

and therefore, a person of ordinary skill in the art would have no reason to look to the teachings of Ruckdashel '942. A review of the teachings of Havekost '119, Nguyen '021, and Ruckdashel '942 reveals that, in fact, there is no disclosure or teaching in any of them that would suggest or motivate their combination.

Accordingly, the Office Action has failed to present a *prima facie* case of obviousness for claim 9. In view of the foregoing, it is respectfully submitted that the rejection of claim 9 is improper and should be withdrawn, and it also respectfully requested that claim 9 be allowed to issue.

VI. A Prima Facie Case of Obviousness Has Not Been Made With Respect to Claims 5 and 32

Rather than provide the requisite particularized showing of the teaching or suggestion to combine Havekost '119 and Baker '204, the Office Action improperly relies on the teachings of one of the references to provide the motivation to combine and simply declares that it would have been obvious to combine the two references because their combination would have yielded the benefits of Applicants' invention.

Via. Claim 5

The *entirety* of the Office Action's statement regarding the motivation to combine Havekost '119 and Baker '204 reads as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teaching of XML-based notifications as taught by Baker to the invention of Havekost because XML documents tie services and application server events together in a meaningful way, forming a coherent set of applications.

(Office Action, p.12.)

It is respectfully submitted that the examiner has cited a beneficial result of what Baker '204 teaches and stated that it would be obvious to combine the references because of the beneficial result. Such a statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination. The fact that a combination *can* be made to

get the beneficial results that the Applicants disclosed does not amount to a motivation found *in the art* to make that very combination.

Additionally, as previously indicated, Havekost '119 is directed to a process control system with alarm priority adjustments that enables a user to adjust the priority level of alarm conditions. Baker '204 is directed to system that provides index performance alerts based upon price performance measures of each industry, sector, sub-sector, or group. *See* Baker '204 at col. 3, lines 11-33. The alerts are provided via standard e-mail as well as XML using push technology. *See* Baker '204 at col. 17, lines 40-46. Baker '204 is relied upon to teach the step of receiving an XML-based notification that comprises a notification classification tag and a notification type tag. A review of the teachings of Havekost '119 and Baker '204 reveals that there is no teaching or suggestion of a notification classification tag or a notification type tag in either reference.

Accordingly, the Office Action has failed to present a *prima facie* case of obviousness for claim 5. In view of the foregoing it is respectfully submitted that the rejection of claim 5 is improper and should be withdrawn and it is also respectfully requested that claim 5 be allowed to issue.

VIb. Claim 32

The Office Action provides *no showing* of *any* teaching or suggestion to combine the references with respect to this claim. Instead, the Office Action simply rejects these claim with the introductory wording "Havekost as modified teaches ..." and then refers to the teachings of Baker' '204 to state that the combined references teach what is claimed.

It is respectfully submitted that the rejection of claim 32 is improper because it does not put forth any motivation to combine the references. (*See Lee*, at 1434 ("Omission of a relevant factor [i.e. motivation to combine] required by precedent is both legal error and arbitrary agency action....").)

Furthermore, as explained in the instant application, a short version of a notification is an abbreviated version of the same notification. The instant application provides an example of a short version of a notification (e.g., "Microsoft up 2 at 82") and a long version of the notification (e.g., "Microsoft up 2 at 82 on increased volume"). *See* Application Ser. No. 09/705,858 at page

18, lines 17-20. A review of the teachings of Havekost '119 and Baker '204 reveals that there is no teaching of a long version or a short version of a notification in either of the references.

Accordingly, the Office Action has failed to present a prima facie case of obviousness for claim 32. It is respectfully submitted that the rejection of claim 32 is improper and should be withdrawn and it is also respectfully requested that claim 32 be allowed to issue.

VII. A Prima Facie Case of Obviousness Has Not Been Made With Respect to Claims 7, 8, 24, and 25

Rather than provide the requisite particularized showing of the teaching or suggestion to combine Havekost '119, Nguyen '021 and Harrison '128, the Office Action improperly relies on a statement in the background section of Harrison '128 to provide the motivation to combine and simply declares that it would have been obvious to combine the two references because their combination would have yielded the benefits of Applicant's invention.

The *entirety* of the Office Action's statement regarding the motivation to combine Havekost '119, Nguyen '021, and Harrison '128 reads as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the teaching of alpha-blended displays as taught by Harrison to the invention of Havekost as modified because variably-transparent GUIs allow multiple object image layers to be simultaneously observed.

(Office Action, p.13.)

It is respectfully submitted that the examiner has quoted from the background section of Harrison '128 (*See* Harrison '128 at col. 2, lines 38-39) a beneficial result of what Harrison '128 teaches and stated that it would be obvious to combine the references because of the beneficial result of using variably-transparent GUIs. Such a simple statement of beneficial results that would follow from a combination is *not* a motivation to actually make the combination.

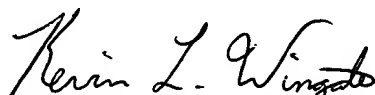
Furthermore, it is respectfully submitted that the stated reason for combining the references is not related in any way to the problem being solved in Havekost '119 (providing a process control system where users can adjust the priority level of alarms), and therefore, a person skilled in the art would not look to combine the Havekost '119 and Harrison '128 references.

Accordingly, the Office Action has failed to present a prima facie case of obviousness for claims 7, 8, 24, and 25. It is respectfully submitted that the rejection of claims 7, 8, 24, and 25 is improper and should be withdrawn and it is also respectfully requested that claims 7, 8, 24, and 25 be allowed to issue.

VIII. Conclusion: Claims 1-32 Are In Condition For Allowance

In view of the entire record and the arguments presented above, the Appellants respectfully submit that claims 1-32 are in condition for allowance. Consideration of the Appeal, removal of the outstanding grounds of rejections, and allowance of claims 1-32 are respectfully solicited.

Respectfully submitted,



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CLAIMS APPENDIX

1. A computer-readable medium having computer-executable instructions for performing steps comprising:
 - receiving a notification at a notification component to provide to a user, the notification component adapted to receive notifications from a plurality of objects and adapted to receive notifications of different notification types;
 - determining a priority to assign the notification based on a user specified priority;
 - deciding a notification type; and
 - rendering the notification in accordance with the priority and the notification type.
2. The computer-readable medium of claim 1 having further computer-executable instructions for performing the step of determining a notification medium to render the notification.
3. The computer-readable medium of claim 1 having further computer-executable instructions for performing the step of determining an area on a display to render the notification.
4. The computer-readable medium of claim 1 wherein the step of receiving the notification comprises the steps of:
 - receiving a property of the notification; and
 - receiving a notification to be sent to the user.
5. The computer-readable medium of claim 1 wherein the step of receiving the notification comprises the step of receiving an XML-based notification, the XML-based notification comprising a notification classification tag and a notification type tag.
6. The computer-readable medium of claim 1 wherein the step of deciding a notification type comprises the step of selecting one of a display notification and an audio notification.

7. The computer-readable medium of claim 6 wherein the step of selecting the display notification comprises selecting one of an alpha-blended display and a transient display.

8. The computer-readable medium of claim 6 wherein the step of selecting the display notification comprises selecting one of an alpha-blended display, a transient display, a transient alpha-blended display, an animated display, and a normal display.

9. The computer-readable medium of claim 6 wherein the step of selecting the one of a display notification and an audio notification comprises the step of selecting one of one of a display notification and an audio notification and a pager notification.

10. The computer-readable medium of claim 1 having further computer-executable instructions for performing the step of queuing the notification.

11. The computer-readable medium of claim 10 wherein the step of queuing the notification comprises the step of queuing the notification in a queue, the queue arranged according to the priority of the notification.

12. The computer-readable medium of claim 10 wherein the step of queuing the notification further comprises the step of flushing a queue of prior notifications.

13. The computer-readable medium of claim 1 wherein the step of determining the priority to assign the notification comprises the step of determining a number of times the user is provided notification.

14. The computer-readable medium of claim 1 having further computer-executable instructions for performing the steps of:

determining a notification classification of the notification;

checking a user preference list to see if the notification classification is listed in a list of selected classifications selected by the user to indicate which notification classifications the user wants to receive; and

wherein the step of rendering the notification comprises the step of rendering the notification if the notification classification is listed in the list of selected classifications.

15. A method of displaying a notification received from one of a plurality of objects at a notification component adapted to receive notifications from the plurality of objects and adapted to receive notifications of different notification classifications, the method comprising the steps of:

determining, by the notification component, a notification classification; and
rendering, by the notification component, the notification in accordance with the notification classification and a user specified priority.

16. The method of claim 15 further comprising the step of determining a notification medium and wherein the step of rendering the notification in accordance with the notification classification comprises the step of rendering the notification in the notification medium in accordance with the notification classification.

17. The method of claim 15 wherein the step of rendering the notification in accordance with the notification classification further comprises the step of rendering the notification in accordance with a user preference.

18. The method of claim 17 wherein the user preference comprises a classification enable, a positional location, and a classification size, the positional location being a location on a display where the notification is to be displayed, the classification size being an area in a display area where the notification is to be displayed, the step of rendering the notification in accordance with a user preference comprises the steps of:

determining if the classification enable is enabled for the notification classification; and
if the classification enable is enabled for the notification classification, rendering the notification at the positional location and at a size equal to the classification size.

19. The method of claim 15 wherein the step of determining a notification classification comprises the step of selecting one of a contact classification and an audio classification.

20. The method of claim 19 wherein the step of selecting one of a contact classification and an audio classification comprises the step of selecting one of a contact classification, a financial classification, and an audio classification.

21. The method of claim 19 wherein if the step of selecting one of the contact classification and the audio classification comprises the step of selecting the audio classification, the step of rendering the notification further comprises the step of sending a pre-notification notification to a user prior to performing the step of rendering the notification.

22. The method of claim 19 wherein the notification comprises a text message and if the step of selecting one of the contact classification and the audio classification comprises selecting the audio classification, the step of rendering the notification further comprises the step of converting the text message into an audio message prior to performing the step of rendering the notification.

23. The method of claim 15 further comprising the step of selecting a rendering type and wherein the step of rendering the notification in accordance with the notification classification further comprises the step of rendering the notification using the rendering type.

24. The method of claim 23 wherein the step of selecting the rendering type comprises selecting one of an alpha blending display and a transparent display.

25. The method of claim 23 wherein the step of selecting the rendering type comprises selecting one of an alpha-blended display, a transient display, a transient alpha-blended display, an animated display, and a normal display.

26. The method of claim 15 further comprising the step of updating a history of notifications.

27. The method of claim 26 wherein the step of updating a history comprises the steps of:

flushing read items from the history that have been read by a user; and
flushing old items from the history, the old items determined from the user preference.

28. The method of claim 27 further comprising the step of displaying items in the history in accordance with the user preference.

29. The method of claim 26 further comprising the steps of:
displaying the history; and
performing at least one action if a notification in the history is selected by a user selection device.

30. The method of claim 15 further comprising the step of performing at least one action if the notification is selected by a user selection device.

31. The method of claim 15 further comprising the step of:
if the notification classification is an audio notification classification, performing at least one action if one of a keyword and a key-phrase is spoken by a user.

32. The method of claim 15 wherein the step of rendering the notification further comprises the step of rendering the notification in one of a long version and a short version, the short version being an abbreviated version of the long version.

In re Appln. of Felix G.T.I. Andrew et al.
Application No. 09/705,858

EVIDENCE APPENDIX

The Appellant submits that there is no evidence entered and relied upon in this appeal.

RELATED PROCEEDINGS APPENDIX

The appellant submits that there are no related appeals or interferences, and therefore there are no decisions rendered by a court or the Board to be provided herein.